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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,509	11/07/2003	Kazuo Kuroda	8014-1056-1	8531
466	7590	06/19/2007	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			WERNER, DAVID N	
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/702,509	KURODA ET AL.
	Examiner	Art Unit
	David N. Werner	2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) 4 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/346,934.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20031107.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is the First Action on the Merits for US Patent Application 10/705,209, which is a division of Application 09/346,934, now US Patent 6,707,774. Currently, claims 1-16 are pending.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/346,934, filed on 02 July 1999.

***Information Disclosure Statement***

3. The information disclosure statement filed 07 November 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Specification***

4. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Objections***

6. Claim 4 is objected to because of the following informality: in line 3, the word "real" should be "read". Appropriate correction is required.

#### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states, "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 2-4, 7, 8, 10-12, and 15-16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 of prior U.S. Patent No. 6,707,774 B1. This is a double patenting rejection.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,707,774

B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the prior patent completely encompasses the subject matter of the present invention. Claims 1 and 9 are broader than claims 1-3 of the prior patent, since they do not disclose the details of the second determination device.

#### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3, 5-7, 9-11, and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 7,117,181 B1 (Nagai et al.). Claims 9-16 of the present invention are mainly coextensive in scope, but claim 9 is in means-plus-function format, and properly invokes 35 U.S.C. 112, sixth paragraph. Accordingly, the invention of claims 9-16 will be limited to a DVD player, as mentioned throughout the specification. Nagai et al. teaches a DVD reproduction apparatus that prevents copying of pirated discs by identifying copy permission data and disc type from reproduced disc data. Regarding claims 1 and 9, figure 1 of Nagai et al. shows a DVD reproduction apparatus. Pickup 102, which detects a signal from disc 101 (column 2, lines 36-37), corresponds with the read device; copying permission detection circuit 108 corresponds with the first determination device (column 2, lines 49-51); disk identification code detection circuit 107 corresponds with the second determination device (column 2, lines 47-49); disk reproduction stopping signal generator 109 corresponds with the output control device (column 2, lines 51-57); and data output terminal 113 corresponds with the output device (column 3, line 1). The disk identification circuit 107 recognizes if the disk is dedicated to reproduction (DVD-ROM) or can be recorded to (DVD-R or DVD-RAM) based on a disk identification code superimposed or embedded on disk 101 (column 2, lines 28-36). Copying permission detection circuit 108 detects if the disk is labeled with copying possible, copying inhibited, or one generation of copying permitted (column 3, lines 21-27). Regarding claims 2, 3, 10, and 11, a second embodiment shown in figure 2 contains wobble detection circuit 116 that judges if a groove-shaped track on the DVD contains a wobble. This wobble is present in recording DVD media specifications like

DVD-RAM or DVD-R, but not in a reproduction DVD-ROM (column 4, lines 28-42).

Regarding claims 5, 6, 13, and 14, again, the disk identification code indicates if the DVD is a reproducible DVD-ROM, or a recordable DVD-R or DVD-RAM (column 1, lines 57-62; column 2, lines 33-36). Regarding claims 7 and 15, the copy permission information may be superimposed on an audio/video signal as a watermark (column 1, lines 15-20).

13. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

#### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai et al. in view of US Patent 5,694,381 (Sako), cited in the Information Disclosure Statement of 07 November 2003. Nagai et al. teaches video identification information, but not necessarily that of CGMS. Sako teaches a CD or DVD player with copy management according to disc type and copy management information CGMS. Regarding claims 8 and 16, figure 11 shows an embodiment of a reproduction apparatus according to Sako. A reproduction prohibition signal PBINH is produced

according to the type of medium and CGMS status of disc 2 (column 9, line 61 – column 10, line 9). The PBINH signal becomes '1' and reproduction is prohibited if the disc is a write-once or erasable disc and the CGMS indicates copy protection (column 9, lines 21-30).

Nagai et al. discloses the claimed invention except for providing copy information as CGMS data. Sako teaches that it was known to manage copy protection of a disc according to CGMS. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide CGMS copy management information to a disc, as taught by Sako, since Sako states in column 10, lines 10-23 that such a modification would enable different segments with different copy information to be recorded onto the same disc.

### ***Conclusion***

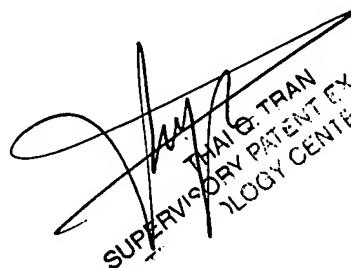
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 5,548,571 (Mistretta) teaches disc type identification by a pattern of holes in a cartridge or caddy housing the disc. US Patent 5,870,375 (Maeda et al.) gives an example of a disc with a wobbled groove. US Patent 5,960,398 (Fuchigami et al.) teaches embedding copyright management information into the burst-cutting area (BCA) of a disc. International Publication WO 98/28913 (Blatter) describes the broadcast flag, a copyright control measure similar to CGMS for digital video broadcasting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Werner whose telephone number is (571) 272-9662. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DNW



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